

**REMARKS**

By this amendment, Claims 1, 12-13, 16 and 18 are amended and new Claims 36-53 are added. No new matter has been introduced by these changes.

The Advisory Action indicates that the proposed claim amendments set forth in the Amendment Under 37 C.F.R. §1.116 filed on November 13, 2003 raise new issues. These same claim amendments are set forth in this Amendment.

Claims 1 and 18 have been amended to recite a cigarette paper wrapper comprising heat-degradable filler particles, "wherein at least some of the heat-degradable filler particles are completely surrounded by the paper." Support for this amendment is provided in the specification at page 9, lines 19-25 and bridging paragraph, page 12, line 21-page 13, line 5. Claim 12 has been amended to incorporate the subject matter of Claim 13, and Claim 13 has been amended to recite the feature that "the heat-degradable filler particles are spheres, pellets, fibers or an irregular shape." Support for this amendment is provided at page 12, lines 21-24 of the specification. Claim 16 has been amended to recite "incorporating heat-degradable filler particles into a cigarette paper wrapper." Support for this amendment is provided at page 6, lines 18-20 of the specification.

**1. Rejection of Claims 1, 6-13, 16-18 and 20-25 under 35 U.S.C. §102(b)**

Claims 1, 6-13, 16-18 and 20-25 stand rejected under 35 USC §102(b) as allegedly being unpatentable over U.S. Patent No. 2,992,647 ("Figge"). The reasons for the rejection are set forth in paragraph 1, on page 2 of the Official Action. This rejection is respectfully traversed for the following reasons.

Claim 1 sets forth "a cigarette comprising a cigarette paper wrapper having heat-degradable filler particles, wherein at least some of the heat-degradable filler particles are completely surrounded by the paper, and wherein said heat-degradable filler particles are capable of being dissipated during smoking of the cigarette to increase the porosity of the

cigarette paper wrapper." The combinations of features recited in Claim 1 and in the claims dependent thereon are not disclosed or suggested by Figge.

Claim 18 sets forth "a cigarette paper wrapper comprising heat-degradable filler particles, wherein at least some of the heat-degradable filler particles are completely surrounded by the paper, and wherein said heat-degradable filler particles are capable of being dissipated to increase porosity of the cigarette paper wrapper during smoking of a cigarette incorporating the cigarette paper wrapper." The combinations of features recited in Claim 18 and in the claims dependent thereon also are not disclosed or suggested by Figge.

As indicated above, Claim 1 is directed to a cigarette and Claim 18 is directed to a cigarette paper wrapper, which comprises heat-degradable filler particles. The heat-degradable filler particles are incorporated into the cigarette paper such that at least some of the heat-degradable filler particles are completely surrounded by the paper. For example, as disclosed at page 9, lines 19-20 of the specification, "the heat-degradable filler particles are typically incorporated as fillers into the cigarette paper during the paper-making process." As disclosed at page 6, lines 19-20, particles of the heat-degradable filler material can be added to a feedstock of a cigarette paper making machine. As further disclosed at page 13, lines 2-4, "it is not necessary to create perforations or holes, as long as the porosity of the cigarette paper is sufficiently increased in advance of the charline." In contrast, Figge discloses a paper or wrapper, which includes holes filled with materials that melt or sublime at low temperatures. The holes of the Figge paper or wrapper are "filled by painting the cigarette paper with materials that melt at low temperatures" (See Figge at column 4, lines 56-64). Accordingly, Figge fails to disclose or suggest "a cigarette paper wrapper having heat-degradable filler particles therein, wherein at least some of the particles are completely surrounded by the paper." As such, withdrawal of this ground of rejection is respectfully requested.

**2. Rejection of Claims 1, 6-8, 12, 16-18 and 20-22 under 35 U.S.C. §102(b)**

Claims 1, 6-8, 12, 16-18 and 20-22 stand rejected under 35 USC §102(b) as allegedly being anticipated by U.S. Patent No. 4,784,164 ("Adam"). The reasons for the rejection are set forth in paragraph 2, on pages 2-3 of the Official Action. This rejection is respectfully traversed for the following reasons.

Adam is directed to a wrapper material, which includes apertures filled with a coating of material that melts during smoking of a cigarette. Accordingly, Adam fails to disclose or suggest "a cigarette paper wrapper having heat-degradable filler particles therein, wherein at least some of the particles are completely surrounded by the paper." As such, withdrawal of this ground of rejection is respectfully requested.

**3. Rejection of Claims 1, 3-4, 10, 14-18, 24 and 26-27 under 35 U.S.C. §102(b)**

Claims 1, 3-4, 10, 14-18, 24 and 26-27 stand rejected under 35 USC §102(b) as allegedly being anticipated by U.S. Patent No. 3,526,904 ("Tamol"). The reasons for the rejection are set forth in paragraph 3, on pages 3-4 of the Official Action. This rejection is respectfully traversed for the following reasons.

Tamol discloses a cigarette wrapper which includes holes, which are covered by a film of a substance that is disintegrated by the action of smoke constituents during burning of the tobacco (Abstract of Tamol). Accordingly, Tamol fails to disclose or suggest "a cigarette paper wrapper having heat-degradable filler particles therein, wherein at least some of the particles are completely surrounded by the paper." As such, withdrawal of this ground of rejection is respectfully requested.

**4. Rejection of Claims 12-5 and 19 under 37 U.S.C. §103(a)**

Claims 2-5 and 19 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Figge. The reasons for the rejection are set forth in paragraph 4, on pages 4-5 of the Official Action. The Official Action alleges that the claimed air dilution and

porosity would have been provided by the material that fills the holes of Figge. This rejection is respectfully traversed for the following reasons.

As explained above, Figge fails to disclose or suggest the combinations of features recited in Claims 1 and 18. As Claims 2-5 and 19 depend from Claims 1 and 18, it is submitted that Claims 2-5 and 19 also are patentable over Figge for at least the reasons discussed above. Accordingly, withdrawal of this ground of rejection is respectfully requested.

**5. Rejection of Claims 11, 9, 10, 16-18, 23-24 and 28-35 under 35 U.S.C. §103(a)**

Claims 1, 9, 10, 16-18, 23-24 and 28-35 stand rejected under 35 USC §103(a) as allegedly being unpatentable over U.S. Patent No. 4,607,647 ("Dashley"). The reasons for the rejection are set forth in paragraph 5, on pages 5-6 of the Official Action. The Official Action alleges that increasing the porosity of the cigarette paper wrapper would be expected in the Dashley cigarette paper wrapper. This rejection is respectfully traversed for the following reasons.

Dashley discloses a low sidestream paper for a smoking article wherein the paper has a substantially uniform distribution of a stain resist substance (column 1, lines 47-51 of Dashley). Dashley discloses that the substances are applied as a "coating" to the paper in emulsion solution or other suitable form (paragraph bridging columns 1-2 of Dashley). Further, while the coating may be added to the paper at the papermaking stage, Dashley fails to disclose or suggest "a cigarette paper wrapper having heat-degradable filler particles therein, wherein at least some of the particles are completely surrounded by the paper. Accordingly, withdrawal of this ground of rejection is respectfully requested."

**6. Rejection of Claims 1, 10, 16-18 and 24 under 35U.S.C. §103(a)**

Claims 1, 10, 16-18 and 24 stand rejected under 35 USC §103(a) as allegedly being unpatentable over U.S. Patent No. 5,105,837 ("Barnes"). Barnes discloses a wrapper

chemically treated with a burn retardant in order to substantially reduce the burn-out of the cellulosic content of the paper while maintaining the desired consistency and amount of air to the periphery of a burning fuel element during lighting and throughout smoking (column 7, lines 34-41 of Barnes). The burn retardant is incorporated into a base innerwrap and/or outerwrap during processing and a char-lightening agent and other additives are applied to the outerwrap as a coating (column 7, lines 55-59 of Barnes). The porosity of the base wrapper is stated to be decreased by application of the coating and that after lighting of the smoking article the coating decomposes so that the porosity of the coated paper approaches that of the base wrapper (column 7, lines 59-65 of Barnes). Barnes fails to disclose or suggest, however, a cigarette paper wrapper having heat-degradable filler particles therein, wherein at least some of the particles are surrounded by the paper. As such, withdrawal of this ground of rejection is respectfully requested.

7. **Rejection of Claims 1, 9, 11, 16-18 and 23 under 37 U.S.C. §103(a)**

Claims 1, 9, 11, 16-18 and 23 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Barnes in view of U.S. Patent No. 5,878,754 ("Peterson"). The reasons for the rejection are set forth in paragraph 8, on page 7 of the Official Action. This rejection is respectfully traversed for the following reasons.

As discussed above, Barnes discloses a wrapper chemically treated with a burn retardant. Peterson fails to cure the deficiencies of Barnes. As acknowledged in the Official Action, Peterson does not disclose heat degradable filler particles capable of being dissipated during smoking to increase the porosity of the cigarette paper wrapper. As such, the combination of Barnes and Peterson cannot possibly suggest the combinations of features recited in Claims 1 and 18. Therefore, withdrawal of this ground of rejection is respectfully requested.

**8. New Claims**

New Claims 36-53 are added. New independent Claim 36 recites a cigarette comprising "a cigarette paper wrapper having heat-degradable filler particles, wherein said cigarette paper wrapper is free of perforations prior to smoking of the cigarette." New independent Claim 47 recites "a cigarette paper wrapper comprising heat-degradable filler particles, wherein said cigarette paper wrapper is free of perforations." Support for Claims 36 and 47 is provided at page 12, line 21-page 13, line 5 of the specification. Claims 36 and 47, as well as the claims dependent therefrom, are patentable over the prior art references, which fail to disclose particles of a heat-degradable filler material incorporated into a non-perforated cigarette paper.

It is submitted that the differences between the claimed subject matter and the prior art are such that the claimed subject matter, as a whole, would not have been obvious at the time the invention was made to a person having ordinary skill in the art.

In view of the foregoing, it is submitted that the present application is in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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